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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/867,049	<b>Applicant(s)</b> NYMAN ET AL.	
	<b>Examiner</b> Zachary A Davis	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 190 (see page 14, line 6 of paragraph 91), 191 (page 15, line 10 of paragraph 93), and 239 (page 17, lines 3 and 4).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 231 and 243 (see Figure 2).
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: The specification appears to contain minor errors. For example, on page 5, line 4 of paragraph 25, a word appears to be missing from the phrase "the range of a local wireless link up to about 10 meters" and on page 14, line 7 of paragraph 91, reference is made to "gateway 190" whereas elsewhere in the specification and in the Figures, the gateway is element 150.

Appropriate correction is required. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

5. Claims 18, 21-24, and 37 are objected to because of the following informalities:

Claim 18 recites the limitation "the a means" in lines 1 and 4 of the claim. It appears this is intended to read "the means". Similarly, Claims 21-24 each recite "the a means" in line 1 of each claim; it appears these are each intended to read "the means".

Claim 37 recites "a device for authentication a client" in lines 1-2 of the claim. It appears this is intended to read "a device for authenticating a client".

Appropriate correction is required.

6. Applicant is advised that should claim 35 be found allowable, claim 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-34 of copending Application No. 09/858,264 (see US

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Patent Application Publication 2002/0169958). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 35-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 25 of copending Application No. 09/858,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 35 and 36 of the present application are simply directed to a software implementation of the method disclosed in Claim 7 of the copending application, which also incorporates all of the limitations disclosed in Claim 1 of the copending application. Similarly, Claim 37 of the present application is solely directed to a software implementation of the method disclosed in Claim 25 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 35-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 35-37 are directed to computer program products that recite computer executable program code *per se*. The computer executable code is not tangibly embodied in a computer readable medium, and is therefore not statutory. See MPEP § 2106 IV.B.1(a).

13. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the statutory classes of invention.

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-24 and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the subscriber identity module" in lines 13-14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the subscriber identity module" in lines 13-14 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the step of transmitting" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "The method according to claim 16"; however, Claim 16 is directed to a client. Further, the claim recites the limitation "the step of using" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "the method" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



17. Claims 1-10, 13-22, and 25-37 rejected under 35 U.S.C. 102(e) as being anticipated by Turtiainen, US Patent 6430407.

In reference to Claim 1, Turtiainen discloses a method for authenticating a client to a communication system including receiving a subscriber identity from a mobile station (column 9, lines 29-37 and 45-49) where a mobile telecommunication network is separate from the communication system to which the client is being authenticated (column 8, lines 1-7), sending the subscriber identity, receiving a challenge and a secret, and using a response to the challenge and the secret to authenticate the client (column 10, lines 22-39).

In reference to Claims 2, 3, and 8, Turtiainen further discloses receiving a PIN (column 10, lines 26-30) and encrypting the PIN (column 9, line 66-column 10, line 9).

In reference to Claims 4 and 5, Turtiainen further discloses encrypting and transmitting the response (column 10, lines 6-9).

In reference to Claims 6 and 7, Turtiainen further discloses that the transmissions and receptions are performed wirelessly (column 6, lines 18-25).

In reference to Claims 9 and 10, Turtiainen further discloses that the wireless transmissions can use an infrared signal or a radio signal (column 10, lines 51-55).

In reference to Claim 25, Turtiainen discloses a method including retrieving and sending a subscriber identity (column 9, lines 29-37 and 45-49), receiving a challenge, and generating and sending a secret in response to the challenge (column 10, lines 22-39).

In reference to Claims 26, 27, 28, and 29, Turtiainen further discloses receiving a request containing an encrypted PIN and confirming the PIN (column 9, line 66-column 10, line 9; column 10, lines 22-39).

Claims 13-22 and 30-34 are apparatus claims corresponding substantially to the methods of Claims 1-10 and 25-29, respectively, and are rejected by a similar rationale.

Claims 35 and 36 are directed to software implementations of the method of Claim 7, and are rejected by a similar rationale. Similarly, Claim 37 is directed to a software implementation of the method of Claim 25, and is rejected by a similar rationale.

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 11-12 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turtiainen in view of Lightman et al, US Patent 6711414.

In reference to Claims 11 and 12, Turtiainen discloses everything as applied to Claim 8 above. Turtiainen also discloses that the wireless transmissions can have any "suitable operational connection" (column 10, lines 53-54); however, Turtiainen does not

explicitly disclose the use of a low power radio signal or an acoustic signal for the wireless transmissions.

Lightman discloses a wireless communication apparatus that can transmit wireless signals using an infrared signal, a Bluetooth (low power radio) signal, a radio frequency signal, or an acoustic signal (column 6, lines 36-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Turtiainen to use a low power radio signal or acoustic signal for the wireless transmissions, in order to allow the wireless communication devices to easily transmit to and receive from other devices, and to allow the wireless devices to interact with other devices and their surroundings (see Lightman, column 3, lines 19-28).

Claims 23-24 are apparatus claims corresponding substantially to the methods of Claims 11-12, and are rejected by a similar rationale.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Bilgic et al, US Patent 6097817, disclose a communication system including wired and wireless networks and authentication of a user's SIM card.
- b. Waugh, US Patent 6104928, discloses a system for integration of dual networks, including mobile stations with identification in SIMs.

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- c. Floden et al, US Patent 6230002, disclose an apparatus for improving authentication security in a wireless host connected to a private network.
- d. Park et al, US Patent 6714799, disclose a system for using a GSM SIM card in a second CDMA network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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